

USSN: 09/757,175
Atty. Docket No.: 10234/2
Response dated November 22, 2004
Reply to final Office Action of September 22, 2004

REMARKS/ARGUMENTS

Claims 1, 3-5, 8-27, 29, and 31-38 are all the claims pending in the application.

The final Office Action contains a single rejection. At Section 4, pages 2-4, of the final Action, Claims 1, 3-5, 29, 31-36, and 38 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 4,758,462 to Park, *et al.* ("Park") in view of U.S. Patent 5,443,915 to Wilkie, *et al.* ("Wilkie").

Applicants respectfully traverse.

The Examiner's proposed combination of Park and Wilkie is improper because a proposed modification or combination of the prior art cannot change the *principle of operation* of the prior art invention being modified. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Here, modifying Park by reference to Wilkie changes Park's principle of operation.

Park contains multiple disclosures that make it clear that the principle of operation of Park's invention is based on a voided core layer. Besides its Summary of the Invention and its Abstract, both of which clearly disclose the requirement of a void-containing core layer, Park at column 2, lines 53-58, discloses the importance of the core thickness, "in combination with the population and configuration of the voids." Then, at column 4, lines 20-27, Park discloses the voids of the core (specifically, their particular dimensions) as a "necessary part of the present invention." (Emphasis added.) Applicants also refer to column 3, lines 13-37.

In fact, Applicants have closely reviewed Park's disclosure, and Applicants would like to point out that a vast majority of each of columns 2 through 5 is concerned with voids in the core, void-formation in the core and the void profile of the core layer. When combined with the fact that column 1 of Park merely discusses the background of the invention, and columns 6+ contain the examples and claims, it is a reasonable estimate that over 75% of Park's summary and detailed description of its invention relates directly to the cavitated core layer. Yet the Examiner's proposed modification to Park would completely contravene this aspect of Park's disclosure.

USSN: 09/757,175
Atty. Docket No.: 10234/2
Response dated November 22, 2004
Reply to final Office Action of September 22, 2004

Accordingly, modifying Park to remove its voided core layer would destroy Park's principle of operation.

In addition, modifying Park by reference to Wilkie is contrary to, and destroys, Park's disclosure of its core layer. The inventors of Park were specifically aware of void-free layer technology and opacifying agents, such as TiO₂ pigment. Park's skin layers are disclosed as being void-free at column 2, line 12, and Park discloses the use of TiO₂ pigments at columns 3 and 4, for example. Nevertheless, the Park inventors specifically chose to make their core layer a voided core layer. Therefore, it would be completely contrary to, and destroy, Park's disclosure to modify its core layer by making it void-free.

The Examiner has specifically addressed the above arguments in the paragraph bridging pages 3 and 4 of the final Action and the first full paragraph at page 4 of the final Action. In the paragraph bridging pages 3 and 4 of the final Action, the Examiner states (emphasis in the original):

Second, importantly, while Park's invention uses a voided core to provide opaqueness to the opaque multilayered films, Wilkie's invention is clearly directed to the same intended purpose, i.e., an opaque multilayer film, as set forth above. As such, while substituting Park's voided core layer with Wilkie's nonporous layer changes the physical structure of the core layer, it clearly does not destroy Park's principle of operation, i.e., to obtain an opaque multilayered film. Applicants' argument to the contrary not withstanding. See MPEP 2143.01.

Applicants respectfully disagree with the Examiner's remark excerpted above and the remarks at the paragraph bridging pages 3 and 4 of the final Action and the first full paragraph at page 4 of the final Action. For the reasons below, Applicants kindly request the Examiner to reconsider his position and withdraw the §103 rejection of Claims 1, 3-5, 29, 31-36, and 38.

Specifically, the Examiner has confused the following two separate bases presented at MPEP §2143.01 for rebutting a *prima facie* case of obviousness (emphasis added):

USSN: 09/757,175
Atty. Docket No.: 10234/2
Response dated November 22, 2004
Reply to final Office Action of September 22, 2004

- (i) a *prima facie* case of obviousness is rebutted where the proposed modification to the prior art would render the prior art being modified unsatisfactory for its *intended purpose*. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); and
- (ii) a *prima facie* case of obviousness is rebutted where the proposed modification to the prior art would change the *principle of operation* of the prior art invention being modified. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Examiner's remarks at the paragraph bridging pages 3 and 4 of the final Action relate to (i) above. That is, the intended purpose of Park, in the broadest sense, is to provide an opaque film composite, and the Examiner's position is that modifying Park by reference to Wilkie does not render Park unsatisfactory for its intended purpose of providing an opaque film composite.

However, with respect to (ii) above, the Examiner's remarks at the paragraph bridging pages 3 and 4 of the final Action do not at all change the fact that modifying Park by reference to Wilkie changes Park's principle of operation.

By its plain meaning, a product's "principle of operation" is the underlying manner or method by which it operates or functions. Park's principle of operation is the provision of a void-containing core layer. Thus, modifying Park by reference to Wilkie as proposed by the Examiner changes Park's principle of operation because it removes Park's void-containing core layer.

Finally, there is a separate, additional reason why the combination of Park and Wilkie does not render obvious the claimed invention.

The Examiner's basic position is that "it would have been obvious to one of ordinary skill in the art to modify Park's core layer with an opaque polyolefin layer, as taught by Wilkie, motivated by the desire to obtain a substantially nonporous opaque multilayer film with

USSN: 09/757,175
Atty. Docket No.: 10234/2
Response dated November 22, 2004
Reply to final Office Action of September 22, 2004

improved mechanical strength." Applicants refer to the paragraph bridging pages 2 and 3 of the final Action.

However, Wilkie's titanium dioxide-containing cold seal receptive layer "is not opaque in and of itself" Column 5, lines 61-64.


For each of the foregoing reasons, it is unreasonable to propose (i) that a person of ordinary skill in the art would look to Wilkie in order to modify Park's disclosure in the manner proposed by the Examiner and (ii) that doing so would lead to the presently claimed invention. Applicants respectfully request that the Examiner reconsider and withdraw the remaining §103 rejection.

The Examiner is reminded that upon the allowance of the elected claims, Claim 38 is a linking claim.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: November 22, 2004


Rick F. James
Registration No. 48,772

Post Office Address (to which correspondence is to be sent)
ExxonMobil Chemical Company
Law Technology
P.O. Box 2149
Baytown, Texas 77522-2149
Telephone No. (281) 834-2438
Facsimile No. (281) 834-2495